

CERTIFICATE OF MAILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being electronically transmitted on the date noted below to: Mail Stop Patent Ext., Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: September 15, 2008 Name: Tadashi Horie, Reg. No. 40,437 Signature: 

**BRINKS
HOFER
GILSON
& LIONE**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: **Moritani et al.**

Appln. No.: **10/810,079**

Filed: **March 26, 2004**

For: **MOBILE COMMUNICATION SYSTEM, MOBILE
TERMINAL, AND MOBILE COMMUNICATION
METHOD**

Docket No: **9683/181**

Examiner: **Farah Faroul**

Art Unit: **2616**

Conf. No.: **3522**

TRANSMITTAL

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is/are:

☒ Transmittal; Request for Reconsideration of Patent Term Adjustment (4 Pages); Exhibit A - F.

Fee calculation:

- ☒ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 CFR § 1.136(a).
- ☐ A petition or processing fee in an amount of \$_____ under 37 CFR § 1.17(_____).
- ☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	OR	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x 105=			x \$210=	
First Presentation of Multiple Dep. Claim					+\$185=			+\$370=	
					Total	\$		Total	\$

Fee payment:

- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$_ for _.
- ☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925. A duplicate is enclosed.

Respectfully submitted,

September 15, 2008
Date


Tadashi Horie Reg. No. 40,437

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September 15, 2008
Date of Deposit

Tadashi Horie (Reg. No. 40,437)
Name of applicant, assignee or Registered
Representative


Signature

Case No. 9683/181
Client Ref. No. FP04-0076-00US-NT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Moritani et al.

Examiner: Farah Faroul

Serial No: 10/810,079

Group Art Unit: 2616

Patent No.: 7,400,601

Filed: March 26, 2004

Conf. No.: 3522

For: MOBILE COMMUNICATION SYSTEM,
MOBILE TERMINAL, AND MOBILE
COMMUNICATION METHOD

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
PURSUANT TO 37 C.F.R. § 1.705(d)

Mail Stop Patent Ext.
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

U.S. Patent No. 7,400,601 issued on July 15, 2008. Pursuant to 35 U.S.C. § 154(b), the United States Patent and Trademark Office has calculated a patent term adjustment of 789 days. A copy of the issue notification for U.S. Patent No. 7,400,601 is included as Exhibit A.

Assignee believes that the patent term adjustment should be 881 days. For the reasons stated herein, reconsideration of this patent term adjustment is respectfully

requested pursuant to 37 C.F.R. 1.705(d). Please charge the petition fee pursuant to 37 C.F.R. § 1.18(e) to Deposit Account No. 23-1925. Please charge any additional fee required or credit for any excess fee paid to Deposit Account No. 23-1925.

The U.S. Patent and Trademark Office calculated the patent term adjustment for U.S. Patent No. 7,400,601 based on activities and associated dates detailed in the Patent Application Information Retrieval (PAIR) system Patent Term Adjustment History, which is attached as Exhibit B. Assignee believes that errors and/or omissions in the calculation and/or the PAIR system Patent Term Adjustment History may have resulted in an incorrect patent term adjustment for U.S. Patent No. 7,400,601 as described in detail below. Pursuant to 37 C.F.R §1.705(d), this request for reconsideration is being filed within two months of the issue date of the above-referenced patent. Note that U.S. Patent No. 7,400,601 is not subject to a terminal disclaimer.

Period of Adjustment for Activities Prior to Mailing of Notice of Allowance

As detailed in the Patent Term Adjustment History that is attached as Exhibit B, the Notice of Allowance indicates that the patent term adjustment as 789 days. However, Assignee previously indicated in the Request for Review of Patent Term Adjustment mailed May 15, 2008 that this patent term adjustment may be incorrect. The previously filed Request for Review of Patent Term is included as Exhibit C. Accordingly, Assignee maintains that the United States Patent and Trademark may have awarded an extra 57 days of patent term adjustment.

Period of Adjustment Pursuant to 37 C.F.R. § 1.703(b)

The period of adjustment pursuant to 37 C.F.R. § 1.703(b) is the number of days in the period beginning on the day ("the three-year date") after the date that is three years after the date on which the application was filed pursuant to 35 U.S.C. § 111(a).

The present application was filed on March 26, 2004 as evidenced by the official filing receipt, which is attached as Exhibit D. The three-year date determined pursuant to 37 C.F.R. § 1.703(b) is March 26, 2007. The United States Patent and Trademark Office issued an *Ex parte Quayle* Action on July 24, 2007. A copy of the *Ex parte Quayle* Action is attached as Exhibit E. Hence, Assignee recognizes that any delay between March 26, 2007 and July 24, 2007 is already accounted for in the period of adjustment for activities prior to the mailing of the Notice of Allowance. Assignee filed a Request for Continued Examination on December 20, 2007, which is attached as Exhibit F. Assignee maintains that the non-overlapping period of adjustment between July 24, 2007 and December 20, 2007 has not been properly taken into account. Accordingly, Assignee maintains that the non-overlapping period of adjustment pursuant to 37 C.F.R. § 1.703(f) is 149 days. Assignee respectfully requests re-calculation of the patent term adjustment to take this non-overlapping period delay into account.

Total Patent Term Adjustment

For the present application, the total patent term adjustment pursuant to 37 C.F.R. § 1.703(f) is the period of adjustment pursuant to 37 C.F.R. § 1.703 reduced by any delay pursuant to 37 C.F.R. § 1.704. Thus, we believe that the patent term adjustment should be 881 days, instead of the 789 days indicated in the issued patent.

It is respectfully asserted that the patent term adjustment determined by the U.S. Patent and Trademark Office for U.S. Patent No. 7,400,601 may not be correct. Accordingly, Assignee respectfully requests the U.S. Patent and Trademark office to reconsider, and make revisions to the PAIR system Patent Term Adjustment History in view of the previous remarks. In addition, it is respectfully requested that the patent term adjustment be re-calculated by the U.S. Patent and Trademark Office in view of the above remarks. Office personnel are invited to contact Assignee's Attorney via telephone if such communication would be beneficial in fulfilling this request.

Respectfully submitted,



Tadashi Horie
Registration No. 40,437
Attorney for Applicant

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200

EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,079	07/15/2008	7400601	9683/181	3522

79510 7590 06/25/2008
NTT Mobile Communications Network I/BHGL
P.O. Box 10395
Chicago, IL 60610

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment is 789 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site <http://pair.uspto.gov> for additional applicants):

Yuki Moritani, Yokohama-shi, JAPAN;
Yukio Atsumi, Kawasaki-shi, JAPAN;

EXHIBIT B

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/810,079

Filing or 371(c) Date:	03-26-2004	USPTO Delay (PTO) Delay (days):	789
Issue Date of Patent:	07-15-2008	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	0
Post-Issue Petitions (days):	+0	Total PTA (days):	789
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

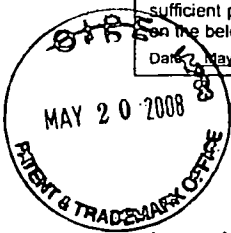
Date	Contents Description	PTO(Days)	APPL(Days)
06-25-2008	PTA 36 Months		
07-15-2008	Patent Issue Date Used in PTA Calculation		
06-17-2008	Dispatch to FDC		
06-16-2008	Application Is Considered Ready for Issue		
06-13-2008	Issue Fee Payment Verified		
06-13-2008	Issue Fee Payment Received		
05-06-2008	Correspondence Address Change		
03-17-2008	Mail Notice of Allowance		
03-17-2008	Mail Examiner's Amendment		
03-14-2008	Document Verification		
03-03-2008	Notice of Allowance Data Verification Completed		
03-03-2008	Case Docketed to Examiner in GAU		
03-03-2008	Examiner's Amendment Communication		
12-20-2007	Substitute Specification Filed		
12-21-2007	Date Forwarded to Examiner		
12-21-2007	Date Forwarded to Examiner		
12-20-2007	Request for Continued Examination (RCE)		
12-21-2007	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		
12-20-2007	Request for Extension of Time - Granted		
12-20-2007	Workflow - Request for RCE - Begin		
07-24-2007	Mail Ex Parte Quayle Action (PTOL - 326)	789	
07-20-2007	Ex Parte Quayle Action	⬆	
08-30-2004	Information Disclosure Statement considered	⬆	
06-28-2007	Case Docketed to Examiner in GAU	⬆	
01-18-2007	Case Docketed to Examiner in GAU	⬆	
03-21-2006	Case Docketed to Examiner in GAU	⬆	
01-27-2006	Case Docketed to Examiner in GAU	⬆	
08-30-2004	Information Disclosure Statement (IDS) Filed	⬆	
08-30-2004	Information Disclosure Statement (IDS) Filed	⬆	
08-17-2004	IFW TSS Processing by Tech Center Complete	⬆	
06-23-2004	Request for Foreign Priority (Priority Papers May Be Included)	⬆	

08-17-2004	Case Docketed to Examiner in GAU	⌆
07-20-2004	Application Return from OIPE	⌆
07-20-2004	Application Return TO OIPE	⌆
07-19-2004	Application Dispatched from OIPE	⌆
07-20-2004	Application Is Now Complete	⌆
06-23-2004	Additional Application Filing Fees	⌆
06-23-2004	A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic	⌆
06-07-2004	Notice Mailed--Application Incomplete--Filing Date Assigned	⌆
04-26-2004	Cleared by OIPE CSR	⌆
04-16-2004	IFW Scan & PACR Auto Security Review	⌆
03-26-2004	Initial Exam Team nn	⌆

Close Window

EXHIBIT C

1fw



CERTIFICATE OF MAILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: May 15, 2008 Name: Gregory H. Zayia, Reg. No. 48,059 Signature: Gregory Zayia

**BRINKS
HOFFER
GILSON
& LIONE**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of:	Moritani et al.	Examiner:	Farah Faroul
Appln. No.:	10/810,079	Art Unit:	2616
Filed:	March 26, 2004	Conf. No.:	3522
For:	MOBILE COMMUNICATION SYSTEM, MOBILE TERMINAL, AND MOBILE COMMUNICATION METHOD		
Docket No:	9683/181		

TRANSMITTAL

Mail Stop Issue Fee
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached is/are:

- ☒ A Transmittal Letter (in duplicate); Request for Review of Patent Term Adjustment and Return Receipt Postcard.

Fee calculation:

- ☒ No additional fee is required.
- ☐ Small Entity.
- ☐ An extension fee in an amount of \$_____ for a _____-month extension of time under 37 CFR § 1.136(a).
- ☐ A petition or processing fee in an amount of \$_____ under 37 CFR § 1.17(_____).
- ☐ An additional filing fee has been calculated as shown below:

					Small Entity			Not a Small Entity	
	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra	Rate	Add'l Fee	OR	Rate	Add'l Fee
Total		Minus			x \$25=			x \$50=	
Indep.		Minus			x 105=			x \$210=	
First Presentation of Multiple Dep. Claim					+\$185=			+\$370=	
					Total	\$		Total	\$

Fee payment:

- ☐ Please charge Deposit Account No. 23-1925 in the amount of \$_ for _.
- ☐ Payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).
- ☒ The Director is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925. A duplicate is enclosed.

Respectfully submitted,

May 15, 2008
Date

Gregory Zayia
Gregory H. Zayia, Reg. No. 48,059



CERTIFICATE OF MAILING UNDER 37 CFR §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on the below date:

Date: May 15, 2008

Name: Gregory H. Zayia, Reg. No. 48,059

Signature: *Gregory Zayia*

Case No. 9683/181

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Moritani et al.

Serial No: 10/810,079

Filed: March 26, 2004

For: MOBILE COMMUNICATION SYSTEM,
MOBILE TERMINAL, AND MOBILE
COMMUNICATION METHOD

Examiner: Farah Faroul

Group Art Unit: 2616

Conf. No.: 3522

REQUEST FOR REVIEW OF PATENT TERM ADJUSTMENT

Mail Stop Issue Fee
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

It has recently come to our attention that there may be an error in the patent term adjustment calculated by the U.S. Patent and Trademark Office for the above-referenced patent application. Specifically, the patent term adjustment pursuant to 35 U.S.C. 154(b) of 789 days indicated on the Determination of Patent Term Adjustment, PTOL-85, may extend the term of this patent by 57 extra days. Please review the calculation of the patent term adjustment and make corrections, if necessary.

Respectfully submitted,

Gregory Zayia

Gregory H. Zayia
Registration No. 48,059
Agent for Applicant

BRINKS HOFER GILSON & LIONE
PO Box 10395
Chicago, IL 60610
312-321-4200

EXHIBIT D



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
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 Alexandria, Virginia 22313-1450
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APPL. NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/810,079	03/26/2004	2661	1158	9683/181	48	10	6

Tadashi Horie
 Brinks Hofer Gilson & Lione
 P.O. Box 10395
 Chicago, IL 60610

CONFIRMATION NO. 3522

UPDATED FILING RECEIPT



OC000000013275128

Date Mailed: 07/20/2004

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

Yuki Moritani, Yokohama-shi, JAPAN;
 Yukio Atsumi, Kawasaki-shi, JAPAN;

Domestic Priority data as claimed by applicant

Foreign Applications

JAPAN P2003-091324 03/28/2003
 JAPAN P2004-045347 02/20/2004

If Required, Foreign Filing License Granted: 06/05/2004

Projected Publication Date: 10/28/2004

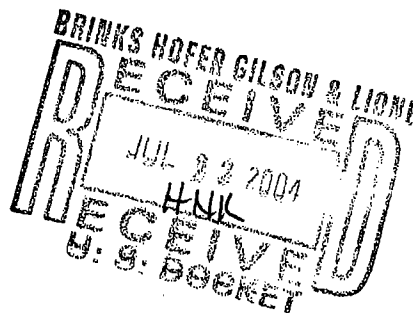
Non-Publication Request: No

Early Publication Request: No

Title

Mobile communication system, mobile terminal, and mobile communication method

Preliminary Class



370

**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

EXHIBIT E



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,079	03/26/2004	Yuki Moritani	9683/181	3522

7590 07/24/2007
Tadashi Horie
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

EXAMINER

FAROUL, FARAH

ART UNIT	PAPER NUMBER
----------	--------------

2616

MAIL DATE	DELIVERY MODE
-----------	---------------

07/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/810,079	Applicant(s) MORITANI ET AL.	
	Examiner Farah Faroul	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>08/30/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following Office Action is based on Application 10/810,079 filed on March 26, 2004, claiming foreign priority from a Japanese application, filed on March 28, 2003, having claims 1-10 and figures 1-48.

2. This application is in condition for allowance except for the following formal matters:

Specification

a) The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

b) Claims 1-10 are objected to because of the following informalities:

Claim 1 recites the limitations: "which can make a copy" in line 6, "can distribute" in line 7, "which can distribute" in line 13 and "which can distribute" in lines 18-19. The limitations render the claim vague. It is advised that applicant remove the word "can" to make the claim affirmative.

Claim 5 recites the limitations: "which can make a copy" in line 6, "can distribute" in line 7, "which can distribute" in line 13 and "which can distribute" in lines 18-19. The limitations render the claim vague. It is advised that applicant remove the word "can" to make the claim affirmative.

Claim 1 recites the limitation "the terminal" in lines 28, 30-31 and 37. There is insufficient antecedent basis for this limitation in the claim. The limitation should be changed to "the mobile terminal".

Claim 1 recites the limitation "the new multicast router" in line 65. There is no antecedent basis for this limitation in the claim. Applicant needs to either amend this limitation to "a new multicast router" or amend the claim to recite "a first multicast router" and "a second multicast router".

Claim 1 recites the limitation "the previous multicast router" in lines 67-68. There is no antecedent basis for this limitation in the claim. The limitation renders the claim vague and indefinite. Applicant needs to specify whether she/she is referring to a first multicast router or a second multicast router.

Claim 3 recites the limitation "a multicast bases" in line 3. The word "bases" seems to be a misspelling of the word "basis". Appropriate correction is required.

Claim 3 recites the limitation "the terminal" in lines 8 and 23. There is insufficient antecedent basis for this limitation in the claim. The limitation should be changed to "the mobile terminal".

Claim 3 recites the limitation "the new multicast router" in line 47. There is no antecedent basis for this limitation in the claim. Applicant needs to either amend this limitation to "a new multicast router" or amend the claim to recite "a first multicast router" and "a second multicast router".

Claim 3 recites the limitation "the previous multicast router" in lines 49-50. There is no antecedent basis for this limitation in the claim. The limitation renders the claim

vague and indefinite. Applicant needs to specify whether she/she is referring to a first multicast router or a second multicast router.

Claim 4 recites the limitation "a multicast bases" in lines 3-4. The word "bases" seems to be a misspelling of the word "basis". Appropriate correction is required.

Claim 4 recites the limitation "the new multicast router" in line 41. There is no antecedent basis for this limitation in the claim. Applicant needs to either amend this limitation to "a new multicast router" or amend the claim to recite "a first multicast router" and "a second multicast router".

Claim 4 recites the limitation "the previous multicast router" in lines 43-44. There is no antecedent basis for this limitation in the claim. The limitation renders the claim vague and indefinite. Applicant needs to specify whether she/she is referring to a first multicast router or a second multicast router.

Claim 5 recites the limitation "the router" in line 10. There is insufficient antecedent basis for this limitation in the claim. The limitation should be changed to "the multicast router".

Claim 5 recites the limitation "the new multicast router" in line 67. There is no antecedent basis for this limitation in the claim. Applicant needs to either amend this limitation to "a new multicast router" or amend the claim to recite "a first multicast router" and "a second multicast router".

Claim 5 recites the limitation "the previous multicast router" in lines 71-72. There is no antecedent basis for this limitation in the claim. The limitation renders the claim

vague and indefinite. Applicant needs to specify whether she/she is referring to a first multicast router or a second multicast router.

Claim 6 recites the limitation "a radio base station" in line 11. Applicant has already cited "a radio base station" in claim 5, line 17. If the "radio base station" in claim 6 is different from the "radio base station" in claim 5, applicant needs to make it clear by either referring to "a second base station".

Claim 6 recites the limitation "the radio base station" in line 12. Application has mentioned two different "radio base station" in claims 5-6. Thus, it is not clear which radio base station is being referred to. Appropriate correction is required.

Claim 6 recites the limitation "the connected radio base station" in lines 20-21 and 31-32. There is no antecedent basis for this limitation in the claim. Applicant has mentioned multiple base stations being connected. Applicant needs to clarify the limitation.

Claim 6 recites the limitation "the detected multicast router" in lines 26-28. There is no antecedent basis for this limitation in the claim. Applicant has mentioned multiple multicast routers. Applicant needs to clarify the limitation.

Claim 6 recites the limitation "the threshold" in lines 32-33. There is insufficient antecedent basis for this limitation in the claim. The limitation should be changed to "the predetermined threshold".

Claim 6 recites the limitation " the recording" in line 33. There is insufficient antecedent basis for this limitation in the claim. The limitation should be changed to "the recording means".

Claim 6 recites the limitation "the multicast routers" in line 33. This limitation is not clear because applicant sometimes refer to "a multicast router" and "the multicast routers". Applicant needs to make it clear how many multicast routers are being claimed.

Claim 7 recites the limitation "the terminal" in line 23. There is insufficient antecedent basis for this limitation in the claim. The limitation should be changed to "the mobile terminal".

Claim 7 recites the limitation "a multicast bases" in line 3. The word "bases" seems to be a misspelling of the word "basis". Appropriate correction is required.

Claim 7 recites the limitation "the new multicast router" in line 47. There is no antecedent basis for this limitation in the claim. Applicant needs to either amend this limitation to "a new multicast router" or amend the claim to recite "a first multicast router" and "a second multicast router".

Claim 7 recites the limitation "the previous multicast router" in lines 51-52. There is no antecedent basis for this limitation in the claim. The limitation renders the claim vague and indefinite. Applicant needs to specify whether she/she is referring to a first multicast router or a second multicast router.

Claim 8 recites the limitation "a radio base station" in line 10. Applicant has already cited "a radio base station" in claim 7, lines 4-5. If the "radio base station" in claim 8 is different from the "radio base station" in claim 7, applicant needs to make it clear by either referring to "a second base station".

Claim 8 recites the limitation "the radio base station" in line 11. Application has mentioned two different "radio base station" in claims 7-8. Thus, it is not clear which radio base station is being referred to. Appropriate correction is required.

Claim 8 recites the limitation " the presence of multicast routers" in lines 8-9. This limitation is not clear because applicant sometimes refer to "a multicast router" and "the multicast routers". Applicant needs to make it clear how many multicast routers are being claimed.

Claim 8 recites the limitation "the connected radio base station" in lines 18-19 and 29-30. There is no antecedent basis for this limitation in the claim. Applicant has mentioned multiple base stations being connected. Applicant needs to clarify the limitation.

Claim 8 recites the limitation "the detected multicast router" in lines 24-25. There is no antecedent basis for this limitation in the claim. Applicant has mentioned multiple multicast routers. Applicant needs to clarify the limitation.

Claim 8 recites the limitation "the connected multicast router" in line 34. There is no antecedent basis for this limitation in the claim. Applicant has mentioned multiple multicast routers. Applicant needs to clarify the limitation.

Claim 8 recites the limitation "the threshold" in lines 30-31. There is insufficient antecedent basis for this limitation in the claim. The limitation should be changed to "the predetermined threshold".

Claim 8 recites the limitation " the recording" in line 31. There is insufficient antecedent basis for this limitation in the claim. The limitation should be changed to "the recording means".

Claim 9 recites the limitation "a multicast bases" in lines 3-4. The word "bases" seems to be a misspelling of the word "basis". Appropriate correction is required.

Claim 9 recites the limitation "the new multicast router" in line 41. There is no antecedent basis for this limitation in the claim. Applicant needs to either amend this limitation to "a new multicast router" or amend the claim to recite "a first multicast router" and "a second multicast router".

Claim 9 recites the limitation "the previous multicast router" in lines 43-44 and 46-47. There is no antecedent basis for this limitation in the claim. The limitation renders the claim vague and indefinite. Applicant needs to specify whether she/she is referring to a first multicast router or a second multicast router.

Claim 10 recites the limitation " the presence of multicast routers" in lines 10-11. This limitation is not clear because applicant sometimes refer to "a multicast router" and "the multicast routers". Applicant needs to make it clear how many multicast routers are being claimed.

Claim 10 recites the limitation "a radio base station" in line 12. Applicant has already cited "a radio base station" in claim 9, line 5. If the "radio base station" in claim 10 is different from the "radio base station" in claim 9, applicant needs to make it clear by either referring to "a second base station".

Claim 10 recites the limitation "the radio base station" in line 13. Application has mentioned two different "radio base station" in claims 9-10. Thus, it is not clear which radio base station is being referred to. Appropriate correction is required.

Claim 10 recites the limitation "the threshold" in line 35. There is insufficient antecedent basis for this limitation in the claim. The limitation should be changed to "the predetermined threshold".

Claim 10 recites the limitation " the recording" in line 35-36. There is insufficient antecedent basis for this limitation in the claim. The limitation should be changed to "the recording means".

Claim 10 recites the limitation "the presence of a multicast router" in line 24. This limitation is not clear because applicant sometimes refer to "a multicast router" and "the multicast routers". Applicant needs to make it clear how many multicast routers are being claimed.

Claim 10 recites the limitation "the multicast routers" in lines 39-40. This limitation is not clear because applicant sometimes refer to "a multicast router" and "the multicast routers". Applicant needs to make it clear how many multicast routers are being claimed.

Claim 10 recites the limitation "the connected radio base station" in lines 22 and 34. There is no antecedent basis for this limitation in the claim. Applicant has mentioned multiple base stations being connected. Applicant needs to clarify the limitation.

Claim 10 recites the limitation "the detected multicast router" in lines 27-28.

There is no antecedent basis for this limitation in the claim. Applicant has mentioned multiple multicast routers. Applicant needs to clarify the limitation.

Claim 10 recites the limitation "the connected multicast router" in line 38. There is no antecedent basis for this limitation in the claim. Applicant has mentioned multiple multicast routers. Applicant needs to clarify the limitation.

Allowable Subject Matter

c) Claims 1-10 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

For claims 1-2, the prior art fails to teach a combination of:

Transmission control means which transmits a first instruction signal for instructing the establishment request transmission means to transmit the path establishing request and a second instruction signal for instructing for instructing the withdrawal request transmission means to transmit the withdrawal request, depending on the detection by the station switching detection means, wherein:

When the station switching detection means detects the switching of the radio base station but the router switching detection means does not detect the switching of the multicast router, the transmission control means sequentially outputs the first

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instruction signal, the second instruction signal, and the first instruction signal again;
and

When the station switching detection means detects the switching of the radio base station and the router switching detection means detects the switching of the multicast router, the transmission control means outputs the first instruction signal to transmit the path establishing request to the new multicast router and thereafter outputs the second instruction signal to transmit the withdrawal request to the previous multicast router

For claim 3, the prior art fails to teach a combination of:

Transmission control means which transmits a first instruction signal for instructing the establishment request transmission means to transmit the path establishing request and a second instruction signal for instructing for instructing the withdrawal request transmission means to transmit the withdrawal request, depending on the detection by the station switching detection means, wherein:

When the station switching detection means detects the switching of the radio base station but the router switching detection means does not detect the switching of the multicast router, the transmission control means sequentially outputs the first instruction signal, the second instruction signal, and the first instruction signal again;
and

When the station switching detection means detects the switching of the radio base station and the router switching detection means detects the switching of the multicast router, the transmission control means outputs the first instruction signal to

transmit the path establishing request to the new multicast router and thereafter outputs the second instruction signal to transmit the withdrawal request to the previous multicast router

For claim 4, the prior art fails to teach a combination of:

A first updating step at which, when the station switching detection means detects the switching of the radio base station but the router switching detection means does not detect the switching of the multicast router, establishment request transmission means of the mobile terminal transmits a path establishing request for requesting the data link layer switch to establish a path for distributing an information signal to the radio base station connected to the mobile terminal itself, at which withdrawal request transmission means of the mobile terminal successively transmits a withdrawal request for requesting the multicast router to withdraw from the multicast group to which the mobile terminal itself belongs, and at which the establishment request transmission means transmits the path establishing request; and

A second updating step at which, when the station switching detection means detects the switching of the radio base station and the router switching detection means detects the switching of the multicast router, the establishment request means transmits the path establishing request to the new multicast router, and the withdrawal request transmission means transmits the withdrawal request to the previous multicast router

For claims 5-6, the prior art fails to teach a combination of:

Transmission control means which transmits a first instruction signal for instructing the establishment request transmission means to transmit the path

establishing request and a second instruction signal for instructing for instructing the withdrawal request transmission means to transmit the withdrawal request, depending on the detection by the station switching detection means, wherein:

When the station switching detection means detects the switching of the radio base station but the router switching detection means does not detect the switching of the multicast router, the transmission control means sequentially outputs the first instruction signal, the second instruction signal, and the first instruction signal again; and

When the station switching detection means detects the switching of the radio base station and the router switching detection means detects the switching of the multicast router, the transmission control means outputs the first instruction signal to transmit the path establishing request to the new multicast router and thereafter outputs the second instruction signal to transmit the withdrawal request to the previous multicast router

For claims 7-8, the prior art fails to teach a combination of:

Transmission control means which transmits a first instruction signal for instructing the establishment request transmission means to transmit the path establishing request and a second instruction signal for instructing for instructing the withdrawal request transmission means to transmit the withdrawal request, depending on the detection by the station switching detection means, wherein:

When the station switching detection means detects the switching of the radio base station but the router switching detection means does not detect the switching of

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the multicast router, the transmission control means sequentially outputs the first instruction signal, the second instruction signal, and the first instruction signal again; and

When the station switching detection means detects the switching of the radio base station and the router switching detection means detects the switching of the multicast router, the transmission control means outputs the first instruction signal to transmit the path establishing request to the new multicast router and thereafter outputs the second instruction signal to transmit the withdrawal request to the previous multicast router

For claims 9-10, the prior art fails to teach a combination of:

A third updating step at which, when the station switching detection means detects the switching of the radio base station but the router switching detection means does not detect the switching of the multicast router, establishment request transmission means of the mobile terminal transmits a path establishing request for requesting the data link layer switch to establish a path for distributing an information signal to the radio base station connected to the mobile terminal itself, at which withdrawal request transmission means of the mobile terminal successively transmits a withdrawal request for requesting the multicast router to withdraw from the multicast group to which the mobile terminal itself belongs, and at which the establishment request transmission means transmits the path establishing request; and

A fourth updating step at which, when the station switching detection means detects the switching of the radio base station and the router switching detection means

detects the switching of the multicast router, the establishment request means transmits the path establishing request to the new multicast router at which the withdrawal request transmission means successively transmits the withdrawal request to the previous multicast router, and at which the establishment request transmission means further transmits the path establishing request to the previous multicast router thereafter

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tonjes et al. (US 2006/0268873 A1), Ekl et al. (US 2003/0083087 A1), Choi et al. (US 2003/0227907 A1) and Kumaki et al. (US 2002/0191562 A1) are cited to show systems pertinent to applicant's invention.

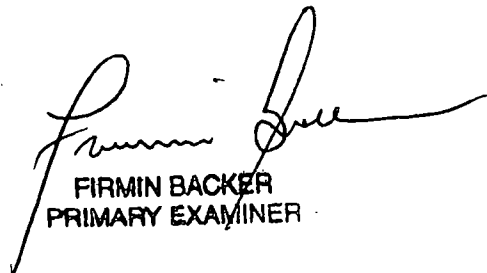
Kumaki et al. (US 2002/0191562 A1) discloses a router device for realizing handoff in mobile terminals. Tonjes discloses a group hopping and channel zapping during transmission of multicast applications. Ekl discloses systems and methods for implementing calls using pre-established multicast groups in a multicast IP network. Choi discloses an apparatus for providing QoS of VoIP traffic on IP router and forwarding method.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farah Faroul whose telephone number is 571-270-1421. The examiner can normally be reached on Monday - Friday 6:30 AM - 4 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Firmin Backer can be reached on 571-272-6703. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

F. Faroul



FIRMIN BACKER
PRIMARY EXAMINER

EXHIBIT F

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being filed electronically with the U.S. Patent and Trademark Office on the below date:

Date: December 20, 2007 Name: Tadashi Horie Reg. No. 40,437 Signature: 

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Appln. of: Yuki MORITANI et al.

Appln. No.: 10/810,079

Filed: March 26, 2004

For: MOBILE COMMUNICATION SYSTEM,
MOBILE TERMINAL, AND MOBILE
COMMUNICATION METHOD

Examiner: Faroul, Farah

Art Unit: 2616

Confirmation No. 3522

Attorney Docket No: 9683/181

Mail Stop RCE
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CONTINUED EXAMINATION (37 C.F.R. § 1.114)

Sir:

Applicant(s) requests continued examination of the above-identified application under 37 C.F.R. §1.114.

☒ Submission under 37 CFR 1.114 (*check at least one of the following*):

☐ Previously submitted:

- ☐ Applicant(s) requests nonentry of any previously-filed unentered amendments.
- ☐ Please enter and consider the Amendment After Final Under 37 C.F.R. §1.116 previously filed on_____.
- ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____.
- ☐ Other: _____.

☒ Attached is/are:

- ☐ An Information Disclosure Statement
- ☒ An Amendment to the written description, claims
- ☐ New Arguments and/or New Evidence in support of Patentability
- ☐ Other: _____

☐ Request for suspension of action:

Applicant(s) hereby requests suspension of action on the above-identified application under 37 C.F.R. §1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; requires Processing Fee under 37 C.F.R. §1.17(i)).

☐ Small Entity Status:

☐ Applicant(s) hereby asserts entitlement to claim small entity status under 37 CFR §§ 1.9 and 1.27.

☐ A small entity statement or assertion of entitlement to claim small entity status was filed in prior application no. _____ / _____ and such status is still proper and desired.

☐ Is no longer desired.

☒ Applicant(s) calculate the following fees to be due in connection with this Request:

☒ A request fee of \$810 under 37 C.F.R. §1.17(e).

☐ A suspension processing fee of \$_____ under 37 C.F.R. §1.17(i).

☐ An additional filing fee of \$_____ under 37 C.F.R. §1.16 (_____ additional independent claims and/or _____ additional total claims).

☒ An extension fee of \$460.00 under 37 C.F.R. §1.17(a) for a two -month extension of time.

☒ Fee payment to cover the above-enumerated fee(s):

☒ Please charge Deposit Account No. 23-1925 (BRINKS HOFER GILSON & LIONE) in the amount of \$1270.00.

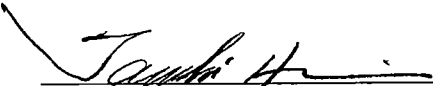
☐ A payment by credit card in the amount of \$_____ (Form PTO-2038 is attached).

☒ The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this paper (including any extension fee required to ensure that this paper is timely filed), or to credit any overpayment, to Deposit Account No. 23-1925 (BRINKS HOFER GILSON & LIONE).

Respectfully submitted,

December 20, 2007

Date


Tadashi Horie (Reg. No. 40,437)